



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/753,297

01/08/2004

Steven M. Miller

RSW920030284US1

7583

51016

7590

10/15/2008

IBM CORP. (RALEIGH SOFTWARE GROUP)  
c/o Rudolf O Siegesmund Yee & Associates, P.C.  
P.O. Box 802333  
DALLAS, TX 75380

EXAMINER

WONG, WILLIAM

ART UNIT

PAPER NUMBER

2178

MAIL DATE

DELIVERY MODE

10/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/753,297	<b>Applicant(s)</b> MILLER ET AL.	
	<b>Examiner</b> WILLIAM WONG	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to the communication filed on 08/07/2008.

- Claims 1-56 have been cancelled.
- Claim 57 has been added.

Claim 57 is pending and has been examined. Previous rejections have been withdrawn in view of amendments.

### ***Claim Objections***

1. Claim 57 is objected to because of the following informalities: As per claim 57, "wherein..." is not a method step, but merely a description of elements described in the previous steps. As such, each "wherein" needs to be clearly associated with the corresponding previous step that includes the corresponding element, and separated with comma instead of a semicolon from the corresponding previous step. "the slides" in line 6 should be replaced with "the plurality of slides" for the purpose of clarity and consistency. There is lack of antecedent basis for "the number of lines on the outline", "the topics above the current topic", "the topics on the outline", "the topics after the current topic", and "the topics before the current topic" in lines 13, 16, 19, 21, and 23. It is unclear the scope of the term "immediately adjacent topics" in line 15. It raises questions such as "immediately adjacent" to what, and how adjacent is "immediately" adjacent. It is also unclear whether applicant intends immediately adjacent topics to not include topics above the current topic (line 16-18), raising question

Art Unit: 2178

as the scope of the term “adjacent”. “in any remaining lines” in line 15 raises questions such as remaining from what. It is unclear the scope of the term “desired” in line 19. The claim describes “current topic of the presentation”, but also describes “topics on the outline”. This raises question as to the difference between a topic of the presentation and a topic of the outline, and which topics are being referred when described, for example, in lines 15, 19, 21, and 23. It is unclear whether there is a difference between “topics above the current topic” and “topics before the current topic”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 57 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claim recites “responsive to a user selecting to expand only a current topic of the presentation on the outline, displaying the outline expanded to only the current topic of the presentation on each slide”. As per the specification in paragraph 53, previous claim 8, and figure 11, the disclosure only describes responding to the above by “expanding only the current topic”. This is not the

Art Unit: 2178

same as "expanding to only the current topic" as recited in the present claim, as this implies that when selection to expand only the current topic is made, that previous topics of the outline are expanded until reaching the current topic. As such, it constitutes new subject matter.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fullerton et al. (US 2001/0033296 A1) in view of Dieberger et al. (US 2003/0122863 A1), Microsoft PowerPoint 2000 (screen printout pages 1-14 demonstrating a step by step guide showing some of the features of PowerPoint 2000), Yacovone et al. (US 2002/0109712 A1), Lee et al. (US 2003/0218639 A1), Gardner et al. (US 2005/0076312 A1), and Banning (US 6380957 B1).

As per independent claim 1, Fullerton teaches **a method comprising: displaying an outline of a plurality of slides of a presentation created by a presentation program** (e.g. in paragraph 14 and 181, "... and (e) program code for presenting the outline data on the display simultaneously with the presentation of the content data" and figure 6); **responsive to a user limiting the topics on the outline, displaying**

Art Unit: 2178

**only desired outline topics that are not limited by the user** (e.g. in paragraph 185, “Users can collapse and expand the outline to see more or less detail”), but as best understood by examiner, does not specifically teach wherein the outline is **in a corner on each** of the plurality of slides, **separating the outline from the remainder of each of the plurality of slides by a user configurable line; wherein the outline is created from a title of each of the slides in the presentation; responsive to a user selecting to expand all levels of topics of the presentation, displaying the outline expanded to all levels on each slide; responsive to a user selecting to expand a user-configurable number of levels of the outline, displaying the outline expanded to the user-configurable number of levels on each slide; and responsive to a user selecting to expand only a current topic of the presentation on the outline, displaying the outline expanded to only the current topic of the presentation on each slide; responsive to a user limiting the number of lines on the outline, displaying the limited number of lines on the outline; wherein immediately adjacent topics are displayed in any remaining lines; and wherein the topics above the current topic are displayed, subject to the user limited number of lines, and then the immediately adjacent topics are displayed, subject to the user limited number of lines; responsive to a user selection to display the topics after the current topic, not displaying previous topics on the outline; and responsive to a user selection to display the topics before the current topic, not displaying subsequent topics on the outline.**

Art Unit: 2178

However, Fullerton teaches that the outline be displayed simultaneously with each slide to provide progress feedback and context information (e.g. in paragraphs 9, 14, and 185) and can be moved around to different areas of the presentation (e.g. in paragraph 180), and Dieberger teaches displaying an outline in a corner on the slides (e.g. in figure 1, outline is shown in the upper left corner, and in abstract, in paragraphs 20-21 and 36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the presentation of Fullerton to include the outline placement and display for each slide of Dieberger because it would provide more viewing space for the presentation content, and easily display the contextual information in a non-intrusive manner (e.g. in paragraph 21 and 25 of page 2).

It was also well known in the art to configure lines/border of elements displayed in a slide show presentation, as shown by Microsoft (e.g. in figures 5-11). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the outline of the combination to include the formatting of Microsoft for the purpose of providing the presentation creator the ability to modify the appearance of the outline.

Yacovone teaches creating the outline from the title of each of the slides in the presentation (e.g. in paragraph 41, "Upon receiving the uploaded content, i.e., presentation slides 38 in this example ... The host system extracts the title of each slide (if PowerPoint®) and stores each slide title in the database for use later during playback by the viewer in the form of

Art Unit: 2178

an active table-of-contents” and figure 6). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of the combination to include the outline creation method of Yacovone for the purpose of automating the generation of the outline data.

Fullerton teaches a hierarchical outline (e.g. in figure 6) and Lee teaches responsive to a user selecting to expand all levels, displaying the hierarchy expanded to all levels (e.g. in figure 5 and in paragraph 28, “As seen by the highlighted background, the user selects the “Expand all” option 510, selecting automatic expansion of the tree. This feature of the invention expands the tree in its entirety”). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify outline of the combination with the expansion option of Lee because it would allow the user to quickly and easily expand the outline for viewing, without having to individually expand the nodes.

Fullerton teaches a hierarchical outline (e.g. in figure 6) and Gardner teaches responsive to a user selecting to expand a user-configurable number of levels of the hierarchy, displaying the hierarchy expanded to the user-configurable number of levels (e.g. in item 30 of figure 1 in view of paragraph 18, “The menu 30 consists of entries to close ancestors of the selected node 20', the selected node 20', and options to individually open the nodes at each level of the hierarchy 40 below the selected node 20'. Each descendent level indicates the number of nodes that would be shown below the



Art Unit: 2178

selected level 20', should the hierarchy 40 be opened to that level"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the outline of the combination to include the expansion option of Gardner because it would allow the user to quickly and easily expand the outline for viewing, without having to individually expand the nodes (e.g. in paragraph 18 on page 2, "The multilevel expand/collapse navigation aid thus saves the user from having either to expand the structure 40 by manually expanding multiple individual nodes 20 within that structure"). Gardner further teaches responsive to a user limiting the number of lines on the hierarchy, displaying the limited number of lines on the hierarchy, wherein immediately adjacent topics are displayed in any remaining lines (e.g. in item 30 of figure 1 in view of paragraphs 21-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the outline of the combination to include the collapse option of Gardner because it would allow the user to quickly and easily limit the number of lines on the outline, without having to individually collapse the nodes. Gardner further teaches responsive to a user selection to display the topics before the current topic, not displaying subsequent topics on the hierarchy, and displaying the hierarchy expanded to only the current topic (e.g. in paragraph 25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the outline of the combination to include the expand to current topic option

Art Unit: 2178

of Gardner because it would allow the user to quickly and easily display topics to the current topic.

Fullerton teaches a hierarchical outline (e.g. in figure 6) and Banning teaches responsive to a user selecting to expand only a current item on the hierarchy, displaying the hierarchy expanding only the current item (e.g. in column 3 lines 32-48), wherein the topics above the current item are displayed, subject to a user limited number of lines, and then the immediately adjacent items are displayed, subject to the user limited number of lines (e.g. in column 2 line 66 - column 3 line 7 and column 3 lines 32-48); and responsive to a user selection to display the items after the current item, not displaying previous items on the hierarchy and responsive to a user selection to display the items before the current item, not displaying subsequent items on the hierarchy (e.g. in column 3 lines 32-48 and column 7 lines 10-13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the outline of the combination to include the teachings of Banning because it would allow the user to focus on the topics of interest.

### ***Response to Arguments***

6. Applicant's arguments filed 08/07/2008 have been fully considered but they are not persuasive.

It is noted that the new independent claim is significantly different than previously presented independent claims, which are now cancelled.

In response to the remaining relevant arguments, Applicant argues in substance that the combination of Fullerton and Dieberger would be duplicating the outline information and that the combination of cited references does not teach displaying the outline on each of the slides. However, examiner respectfully disagrees. There is not any discussion in the rejection regarding the duplication of outline information. The rejection discusses the obvious placement and display method for the outline in the presentation. See rejection above for details. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Moreover, Fullerton teaches that the outline be displayed simultaneously with each slide and, furthermore, Dieberger teaches that the outline (summary view) be displayed for each slide. Therefore, it would have been obvious for the combination to include displaying the outline on each of the slides for the purpose of maintaining progress feedback and context information. See rejection above.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 20030202019 A1      Computer controlled user interactive display  
interface implementation for tracking the  
organization of items in a hierarchical tree of  
nested categories

Detweiler, Keely  
RaNae et al.

Art Unit: 2178

US 20050120239 A1	Integrity monitoring system and data visualization tool for viewing data generated thereby	Monroe, Klayton et al.
US 6944830 B2	System and method for browsing hierarchically based node-link structures based on an estimated degree of interest	Card; Stuart K. et al.
US 6948125 B2	Computer controlled user interactive display interface implementation for tracking the organization of items in a hierarchical tree of nested categories	Detweiler; Keely RaNae et al.
US 20060059441 A1	System and method for displaying a graphical tree hierarchy	Todd; Stephen James
US 20070198930 A1	Methods, Systems and Computer Program Products for Controlling Tree Diagram Graphical User Interfaces and/or For Partially Collapsing Tree Diagrams	Chu; Heng et al.
US 20070266321 A1	Visualizing Navigable Object Hierarchy	Bicker; Sandra et al.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM WONG whose telephone number is 571-270-1399. The examiner can normally be reached on M-F 8:30-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Wong/  
Examiner, Art Unit 2178

/Adam L Basehoar/  
Primary Examiner, Art Unit 2178